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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,347	08/27/2003	Steven R. Reznick	03072	4170

7590 02/26/2009
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EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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02/26/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/649,347	Applicant(s) REZNEK ET AL.	
	Examiner Lyle A. Alexander	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-13, 15-19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-13, 15-19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-23 and 25-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear if the original disclosure the presently claimed limitations. Specifically the original specification does not describe the new amendments to claims 21, 25 and 26. The Office has considered the paragraph provided by Applicant for the support of the above language but did not find literal support.

Claim Rejections - 35 USC § 103

Claims 1-3, 7-13, 15-19 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barthel et al. or Wideman et al.

Wideman et al. teach a method of making a composition comprising carbon black, silica and metal oxide particles in specific size ranges. Torque and BET values monitored to determine the desired characteristics of the composition and have been read on the claimed combination of "*morphological values*" and "*interfacial potential properties*".

Barthel et al. teach a method of preparing carbon black and silica at the specific BET - method surface area (DIN 66131 and 66132) where these characteristics are determined by gas adsorption or inverse gas chromatography. The taught "BET" has been read on the claimed combination of "*morphological values*" and "*interfacial potential properties*".

Barthel et al. and Wideman et al. are silent to the claimed ranges of the morphological values within about 10%, the interfacial potential property value within about 50% and adjusting the process variables to achieve the desired properties.

The court decided In re Boesch (205 USPQ 215) that optimization of a result effective variable is ordinarily within the skill of the art. A result effective variable is one that has well known and predictable results. In a manufacturing process the selection of the acceptable range of product is a result effective variable having the well known and predictable result of providing a product within the manufacturing specification. Specifically, the morphological properties relate to the size of the particle. Okado et al. and Wideman et al. teach specific ranges of particulate size, volume resistivity and/or BET values. It is essential when selling a product for it to conform to the required size, resistivity or BET ranges. It would have been within the skill of the art to modify Okado et al. and only select/sell particles that are within a 10% size/morphological range and within 50% of the resistivity or BET range as optimization of a result effective variable. Also, it is result effective variable to adjust the appropriate input to adjust the desired process variable as optimization of a result effective variable. It would have been within

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the skill of the art to further modify Okado et al., Barthel et al. or Wideman et al. and adjust at least one process variable to achieve the desired result.

These reference are silent to the adjusting the process variable to achieve the desired characteristics of the particles and the specific testing by “wicking rate.”

The court decided In re Boesch (205 USPQ 215) that optimization of a result effective variable is ordinarily within the skill of the art. A result effective variable is one that has well known and predictable results. In a manufacturing process the selection of the acceptable range of product is a result effective variable having the well known and predictable result of providing a product within the manufacturing specification. It is essential when selling a product for it to conform to the required size, resistivity or BET ranges. Also, it is result effective variable to adjust the appropriate input to adjust the desired process variable as optimization of a result effective variable. It would have been within the skill of the art to further modify Okado et al., Barthel et al. or Wideman et al. and adjust at least one process variable to achieve the desired result.

Testing a particulate material by the speed or distance the particulate solution “wicks” is notoriously well known in the art (e.g. for example paper chromatography). Wicking tests are advantageous because they do not require sophisticated equipment and can be performed by the layperson.

It would have been within the skill of the art to modify Okado et al., Barthel et al. or Wideman et al. and use a well known method to test particulate, such as a wicking test, to gain the above advantages.

Response to Arguments

Applicant's arguments filed 12/12/08 have been fully considered but they are not persuasive.

Applicant traverses the 35 USC 112 second paragraph rejections on the grounds Applicant can be their own lexicographer and the terms used in claims 21-23 and 25-26 are proper. It is not clear if the original disclosure the presently claimed limitations. Specifically the original specification does not describe the new amendments to claims 21, 25 and 26. The Office has considered the paragraph provided by Applicant for the support of the above language but did not find literal support.

Applicant state Wildeman et al. teaches measuring torque on a compounded rubber sample and cannot be read on the instant claims. The Office maintains the instant claim language is sufficiently broad and not specific to the state of matter of the particles and has been properly read on the polymerized particles taught by Wilderman et al.

Applicant states Barthel et al. does not provide measurements of interfacial properties as presently described in paragraph[043] of the specification. These remarks are not commensurate in scope with the pending claims because the specific limitations of paragraph[043] are presently not claimed. Even if these limitations were properly claimed, the Office maintains the taught BET is indistinguishable.

Applicant traverse the 35 USC 103 rejections on the grounds the cited reference fail to teach or suggest that interfacial properties are result effective parameters. The court decided In re Boesch (205 USPQ 215) that optimization of a result effective variable is ordinarily within the skill of the art. A result effective variable is one that has

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well known and expected results as explained in the Office action. The Office maintains the 35 USC 103 rejections are proper.

Applicant state the Office cannot hold that chromatography wicking is equivalent to the claimed wicking. In the absence of better defining what is intended by the claimed wicking, the Office maintains the claims are sufficiently broad to have been equated to chromatography wicking.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Lyle A Alexander/

Primary Examiner, Art Unit 1797